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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,968	10/09/2001	Joachim Noack	02565/93	8345
26646	7590	01/14/2004	EXAMINER	
KENYON & KENYON ONE BROADWAY NEW YORK, NY 10004			THOMPSON, KATHRYN L	
			ART UNIT	PAPER NUMBER
			3763	
DATE MAILED: 01/14/2004				

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Offic Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/973,968	NOACK, JOACHIM
	<b>Examiner</b>	<b>Art Unit</b>
	Kathryn L Thompson	3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 03 November 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 6-10 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 09 October 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4, 6</u> | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Election/Restrictions*

Claims 6-10 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 8. Examiner would like to note that in the election of November 3, 2003, Applicant indicated election of Group 1, claims 1-5, "drawn to an apparatus." Since in actuality, claims 1-5 are drawn to a method and not an apparatus, Examiner telephoned Mr. Godlewski to clarify election. Mr. Godlewski, confirmed that the elected claims are 1-5, drawn to a method.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Peabody et al (5,643,201). Peabody et al discloses a method for determining intraperitoneal volume during peritoneal dialysis comprising the steps of passing peritoneal solution from a peritoneal cavity, passing dialyzing fluid, measuring the concentration of an endogenous substance, determining the intraperitoneal volume from the variation in the

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concentration over time, and determining an ultrafiltration rate (Column 4, Line 8 – Column 6, Line 4; Entire reference).

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Simon et al (5,542,919). Simon et al discloses a method for determining intraperitoneal volume during peritoneal dialysis comprising the steps of passing peritoneal solution from a peritoneal cavity, passing dialyzing fluid, measuring the concentration of an endogenous substance, determining the intraperitoneal volume from the variation in the concentration over time, and determining an ultrafiltration rate (Column 2, Line 28 – Column 3, Line 16; Entire reference).

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Tysk et al (3,620,215). Tysk et al discloses a method for determining intraperitoneal volume during peritoneal dialysis comprising the steps of passing peritoneal solution from a peritoneal cavity, passing dialyzing fluid, measuring the concentration of an endogenous substance, determining the intraperitoneal volume from the variation in the concentration over time, and determining an ultrafiltration rate (Entire reference).

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by EPA 0,149,001. EPA 0,149,001 discloses a method for determining intraperitoneal volume during peritoneal dialysis comprising the steps of passing peritoneal solution from a peritoneal cavity, passing dialyzing fluid, measuring the concentration of an endogenous substance, determining the intraperitoneal volume from the variation in the concentration over time, and determining an ultrafiltration rate (Entire reference).

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5 are rejected under 35 U.S.C. 102(e) as being anticipated by Ash (US 6,409,699). Ash discloses a method for determining intraperitoneal volume during peritoneal dialysis comprising the steps of passing peritoneal solution from a peritoneal cavity, passing dialyzing fluid, measuring the concentration of an endogenous substance, determining the intraperitoneal volume from the variation in the concentration over time, and determining an ultrafiltration rate (Column 6, Lines 1 – 56 Entire reference).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Peabody et al, Simon et al, Tysk et al, and EPA 0,149,001 in view of Gauthier et al (US 4,976,683). Peabody et al, Simon et al, Tysk et al, and EPA 0,149,001 teach all of the claimed limitations except wherein the endogenous substance is albumin. Gauthier et al discloses wherein the endogenous substance is albumin (Column 9, Lines 12-22). It would have been obvious to one with ordinary skill in the art to use the teachings of

Gauthier et al to modify the invention of Peabody et al, Simon et al, Tysk et al, and EPA 0,149,001 since the use of albumin as an endogenous substance in dialysis is notoriously well known in the art.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathryn L Thompson whose telephone number is 703-305-3286. The examiner can normally be reached on 8:30 AM - 6:00 PM: 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 703-308-3552. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

KLT

*Kathy*

*Brian Casler*  
BRIAN CASLER  
703-308-3552